

Remarks:

Applicants acknowledge receipt of the Office Action of January 23, 2008, in which the Examiner indicated a defect in the priority claim; objected to the Drawings; rejected claims 1, 3, 5, 7, 10, 11, and 12 under § 112, second paragraph; rejected claims 1 and 4 as anticipated by US 4669650 to Moe ("Moe '650"); rejected claim 2 as obvious in view of Moe '650; rejected claim 3 as obvious over Moe '650 and US 2604569 to Denneen; rejected claim 7 as obvious over Moe '650 and JP 03-243286 to Masakatsu et al.; rejected claims 5-9 as obvious over Moe '650 and Denneen in view of Masakatsu; and rejected claims 10-12 as obvious over Moe '650, Denneen, and Masakatsu in view of US 20030080604 to Vinegar et al.

Applicants respectfully traverse the rejections for the reasons set out below.

Priority Claim

Applicants respectfully point out that a priority claim to European Patent Applications 02077911.2 and 02077912.0 was made in the *Preliminary Amendment* filed with the present application on January 14, 2005. In view of the *Preliminary Amendment*, Applicants believe that the priority claim in the present case is in order and that no further claim is required to establish a priority date of 17 July 2002 for the present case.

In an informal telephone conversation with the undersigned, the Examiner indicated that the priority claim appears to be in order. If, upon further consideration, the Examiner still believes the priority claim to be defective, she is respectfully requested to point out the deficiency so that Applicants can take steps to correct it.

Objection to the Drawings

The specification has been amended to delete the reference numeral "2" from paragraph [0034]. Applicants submit that the amended specification is clear and that this amendment cures the ground for rejection.

Rejection claims 1, 3, 5, 7, 10, 11, and 12 under § 112, second paragraph

The Examiner has objected to the use of the term “substantially” in claims 1, 3, 10, 11, and 12. The term has been deleted from claims 10, 11, and 12, as the deletion does not alter the clear meaning of those claims. Claim 3 has been canceled. Applicants respectfully decline, however, to delete “substantially” from claim 1, where it is used as part of the phrase “expansion into a substantially longitudinally oriented cylindrical shape.”

Applicant submits that the use of the term “substantially” is not *per se* indefinite.¹ See MPEP § 2173.05(b), which states:

The fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. 112, second paragraph. *Seattle Box Co., v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 221 USPQ 568 (Fed. Cir. 1984). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification. . .

[A] court held that the limitation “which produces substantially equal E and H plane illumination patterns” was definite because one of ordinary skill in the art would know what was meant by “substantially equal.” *Andrew Corp. v. Gabriel Electronics*, 847 F.2d 819, 6 USPQ2d 2010 (Fed. Cir. 1988)

As used in claim 1, the term “substantially” is important because it allows the claim to include shapes that are not *precisely* longitudinal. One of ordinary skill in the art would know and understand the difference between a shape that is “substantially longitudinally oriented” and one that is not.²

For all of these reasons, Applicants request that this rejection of claim 1 be reconsidered and withdrawn.

The Examiner also rejected claims 5 and 7 as indefinite. Applicants respectfully submit that claim 5 is clear as written and is not indefinite. Nonetheless, claim 5 has been amended to replace “low grade” and “higher grade” with “relatively lower grade” and “relatively higher grade” to indicate that the claim requires merely that the grade of the steel base pipe be lower than the grade of the cladding, which is a definite and easily ascertainable limitation. Because

¹ In the last ten years alone, over 300,000 patents have issued with the word “substantially” in the claims.

² This is distinguishable from, for example, the phrase “substantially convex” in claim 3, in which “substantially” does not affect the scope of the claim, as an item is either convex or not.

the meaning of the amended claim is the same as the meaning of the claim prior to amendment, the amendments to claim 5 do not constitute new matter.

The phrase “low grade steel” has been deleted from claim 7.

Applicants respectfully submit that these amendments cure the grounds for rejection under § 112, second paragraph.

Rejection of claims 1 and 4 as anticipated by US 4669650 to Moe (“Moe ‘650”)

Claim 1 has been amended to require that “wherein the end face of the wall of one of the tubular ends has a convex shape and the end face of the wall of the other tubular end has a concave shape that is complementary to and intermeshes with said convex shape.” This amendment distinguishes claim 1 over Moe ‘650.

The rejection over Moe in view of Denneen is discussed below.

Rejection of claim 2 as obvious in view of Moe ‘650

Claim 2 depends from claim 1, which is amended as set out above, and is distinguishable for the same reasons.

Rejection of claim 3 as obvious over Moe ‘650 and US 2604569 to Denneen

Claim 1 has been amended to incorporate the limitations of Claim 3, which has been canceled. Claim 3 required that the end face of one of the tubular ends have a convex shape and the end face of the other tubular end have a concave shape. Applicants first submit that Denneen does not, in fact, teach “convex and concave tubular ends,” as asserted by the Examiner. Denneen relates to butt welding of rods, i.e. cylinders rather than tubular goods. The teachings of Denneen say nothing about tubular goods, and a combination of the techniques taught by Denneen with the teachings of Moe would not result in tubular welding meeting the limitations of claim 3.

In addition, to further clarify these distinctions, claim 1 has also been amended, to require that the end face of the wall of each tubular is convex or concave.

Applicants respectfully submit that these amendments cure the ground for rejection of claim 1.

Rejected claim 7 as obvious over Moe '650 and to Masakatsu et al.

Because the amendments to claim 1 distinguish it over Moe '650, Applicants respectfully submit that claim 7 is also allowable.

Rejected claims 5-9 as obvious over Moe '650 and Denneen in view of Masakatsu

Because the amendments to claim 1 distinguish it over Moe '650 and Denneen, Applicants respectfully submit that claims 5-9 are also allowable.

Rejected claims 10-12 as obvious over Moe '650, Denneen, and Masakatsu in view of US 20030080604 to Vinegar et al

Because the amendments to claim 1 distinguish it over Moe '650 and Denneen, Applicants respectfully submit that claims 10-12 are also allowable.

Conclusion

Applicants thank the Examiner for the thoroughness of the Office Action. Applicants have amended the specification and drawings and believe that these amendments place the case in condition for allowance.

If it would be considered helpful in resolving any issues in the case, the Examiner is encouraged to contact the undersigned at the number below.

Respectfully submitted,
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